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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,973	05/20/2004	Heiko Rommelmann	A2132-US-NP	8632

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XEROX CORPORATION  
100 CLINTON AVE., SOUTH, XEROX SQUARE, 20TH FLOOR  
ROCHESTER, NY 14644

EXAMINER

LA, ANH V

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/849,973	<b>Applicant(s)</b> ROMMELMANN ET AL.	
	<b>Examiner</b> Anh V. La	<b>Art Unit</b> 2612	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-14 and 16-19 is/are rejected.  
 7) ☒ Claim(s) 15 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10, 12, 14, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Petteruti.

Regarding claim 1, Petteruti discloses a method of processing a module 24 enclosed within a container 12, wherein the container includes an electronic tag 16a comprising a tag memory, the method comprising while the module is enclosed in the container, selectively storing 22 in the tag memory either first module information or second module information pertaining to the module (column 3, lines 20-50).

Regarding claim 2, Petteruti discloses selectively communicating over a wireless communication link either the first module information or the second module information to the tag (col. 3, lines 20-50).

Regarding claim 3, Petteruti discloses after storing either the first or second module information in the tag memory, electronically reading the stored information pertaining to the module from the tag memory, automatically performing a first action if the tag memory contains the first information and automatically performing a second action if the tag memory contains the second information (col. 4, line 35-col. 5, line 25).

Regarding claim 4, Petteruti discloses installing the module in a printing apparatus 10 for use by the printing apparatus, wherein performing the first action comprises performing the first action in the printing apparatus and wherein performing the second action comprises performing the second action in the printing apparatus (col. 3, lines 20-50).

Regarding claim 5, Petteruti discloses prior to selectively storing the first or second information in the tag memory, electronically reading tag identification information from the tag memory, determining if the read tag identification information matches predetermined identification criteria, storing the first or second module information in the tag memory only if the read tag identification information matches the predetermined identification criteria (col. 3, lines 20-50, figure 3).

Regarding claim 6, Petteruti discloses transmitting an identification read request signal to the electronic tag and electronically receiving an identification response from the tag (col. 4, line 35- col. 5, line 25, figure 3).

Regarding claim 7, Petteruti discloses a calculation (col. 4, line 35- col. 5, line 25, fig. 3).

Regarding claim 8, Petteruti discloses a method for processing a module 24 comprising enclosing the module within a container 12, securely affixing to the container an electronic tag 16a comprising a tag memory, electronically reading tag identification information from the tag memory of the electronic tag securely affixed to the container, electronically verifying that the read tag identification information matches predetermined identification criteria (figure 3), and if the read tag identification

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information matches the predetermined identification criteria, selectively storing in the tag memory either first module information or second module information, which module information pertains to a subsequent use of the module (col. 3, lines 20-50, col. 4, line 25- col. 5, line 25, fig. 3).

Regarding claim 9, Petteruti discloses an identification read request signal and an identification response (col. 4, line 35- col. 5, line 25, fig. 3).

Regarding claim 10, Petteruti discloses a wireless communication link (col. 3, lines 20-50).

Regarding claim 12, Petteruti discloses securing the tag to the container with adhesive (col. 3, lines 5-20).

Regarding claim 14, Petteruti discloses a container 12 for enclosing a module 24 comprising an enclosure 12, and an electronic tag 16a securely affixed to the enclosure (col. 3, lines 5-20), a tag memory, a tag identification segment, a tag identification respond, a tag communication element, a source 22 to transmit tag identification responses generated by the tag identification segment (see figure 3), wherein the tag memory is adapted to store the information received by the tag communication element and wherein the tag memory is adapted to store at least first and second module information pertaining to the module to be enclosed in the container (col. 3, lines 20-50, fig. 3).

Regarding claim 16, Petteruti discloses the tag identification segment being a portion of the tag memory (col. 3, lines 20-50).

Regarding claim 18, Petteruti discloses the electronic tag being embedded in a label secured to the container enclosure (col. 3, lines 5-20).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11, 13, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti in view of Tuttle.

Regarding claims 11, 13, 17, and 19, Petteruti discloses all the claimed subject matter as set forth above in the rejection of claim 8, but does not disclose the container embedding the electronic tag (claims 11, 17) and securing the tag over a container opening separation (claims 13, 19). Tuttle teaches the use of a container 70 embedding an electronic tag 78 (col. 5, lines 25-30) and securing the tag over a container opening separation (figures 6A, 6b, 6). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the container embedding the electronic tag and securing the tag over a container opening separation to the method of Petteruti as taught by Tuttle for the purpose of protecting the container.

5. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Answer to Remarks***

6. Applicant's arguments filed on May 15, 2006 have been fully considered.

Regarding claim 1, applicant has argued that Petteruti fails to disclose "a module enclosed within a container in which the container includes an electronic tag and selectively storing module information while the module is enclosed in the container particularly with such module information pertaining to the module that is enclosed within the container". This argument is not persuasive. Petteruti clearly discloses a module 24 enclosed within a container 12, wherein the container includes an electronic tag 16a comprising a tag memory, and while the module is enclosed in the container, selectively storing 22 in the tag memory either first module information or second module information pertaining to the module (column 3, lines 20-50).

Regarding claim 4, applicant has argued that Petteruti fails to disclose a module for use by a printing apparatus. This argument is not persuasive. Petteruti clearly discloses the module 24 in a printing apparatus 10 for use by the printing apparatus.

Regarding claims 8, 11, and 13, applicant has argued that Petteruti fails to disclose "electronically reading tag information from the tag memory of the electronic tag that is securely affixed to the container enclosing a module". This argument is not persuasive. Petteruti clearly discloses electronically reading tag information from the tag memory of the electronic tag that is securely affixed to the container enclosing a module in figures 1A and 3.

Regarding claims 14, 17, and 19, applicant has argued that Petteruti fails to disclose a container which an electronic tag securely affixed to the enclosure of the container with the container additionally including a tag identification response and a tag communication element. This argument is not persuasive. Petteruti clearly discloses a container 12 in which an electronic tag 16a is securely affixed to the enclosure of the container with the container additionally including a tag identification response and a tag communication element in figure 3 and column 3, lines 20-50.

Applicant's arguments with respect to claim 15 have been fully considered and are persuasive. The rejection of claim 15 has been withdrawn.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh V. La whose telephone number is (571) 272-2970. The examiner can normally be reached on Mon-Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**ANH V. LA**  
**PRIMARY EXAMINER**

Anh V La  
Primary Examiner  
Art Unit 2612

AI  
July 20, 2006